

R E M A R K S

Claims 1-10 are pending in the application. Based on the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections, and withdraw them.

Rejections under 35 U.S.C. § 102

In paragraph 3 of the Office Action, claims 1, 3-7, 9, and 10 were rejected under section 102(e) as being anticipated by Toyooka. This rejection is respectfully traversed as being based on a reference that does not teach the claimed invention.

As recited in claim 1, the invention is directed to a telephone comprising:

- a body formed of a plastic material, wherein at least part of said body includes a section formed of a transparent material;
- an adhesive layer provided on the *rear* face of said section formed of said transparent material;
- colored or lustrous *fine fragments dispersedly applied onto said adhesive layer* so that the fragments are adhesively held on said adhesive layer; and
- a painted layer provided *on said adhesive layer and said colored or lustrous fine fragments*.

Thus, the claimed invention provides a telephone body having decorating layers on its *rear* surface.

According to Toyooka, a transparent resin molded article 17 is covered by a foil-decorating film 1. The foil-decorating film 1 includes an uppermost transparent based film 3, a symbol layer 6 on the base film 3, a hiding layer 7 also laminated on the base film 3, and a transparent adhesive layer 15 laminated on the base film 3. As clearly stated by Toyooka, the symbol layer 6 is for

displaying at least characters or symbols. The hiding layer 7 is understood to be opaque so that edge portions of the display window are defined. The adhesive layer 15 is provided for adhesively bonding the foil-decorating film 1 to the molded article 17. Toyooka describes the base film 3 as having a thickness ranging from 5 μm to 300 μm .

Toyooka is distinguishable from the invention as recited in claim 1 in that in the present invention, the adhesive layer, the fine fragments, and the painted layer are all applied at the *rear* face of the body; whereas in Toyooka, the foil-decorating film 1 (which comprises the transparent base film 3, the symbol layer 6, the hiding layer 7, and the transparent adhesive layer 15) is applied to the *front* face of the body.

Independent claims 3, 5, and 6 similarly recite layers on a *rear* face, whereas Toyooka's layers are applied to the *front* face.

The Office Action references Toyooka's Figures 1 and 2 and column 9, lines 39-51 as disclosing "colored or lustrous fine fragments dispersedly applied onto said adhesive layer so that the fragments are adhesively held on said adhesive layer" as recited in claims 1 and 5. Column 9, lines 39-51 state:

A specific layer arrangement includes the surface protective layer 5, the symbol layer 6, the first color layer 13, the black hiding layer 9, the second color layer 14, the white hiding layer 12, and the transparent adhesive layer 15 which are sequentially laminated on the base film 4 (FIG. 4). That is, the transparent display window 21 surrounded by the black hiding portion 8 and the white hiding portion 12 is defined as a no-hiding-layer portion in which no black hiding layer 9 or no white hiding layer 12 is formed. Materials for the base film 4, the surface protective layer 5, the symbol layer 6, and the transparent adhesive layer 15 are the same as those of the cellular phone top cover of the embodiment described above.

It is respectfully submitted that nowhere in this paragraph is there any description of “colored or lustrous fine fragments,” much less “colored or lustrous fine fragments dispersedly applied onto said adhesive layer.” The stippling used in Toyooka’s Figure 1 in connection with the hiding layer 7 and in Figure 2 in connection with the white hiding layer 12 and the black color hiding layer 18 are consistent with the drawing symbols for loose sand or silicon, or adhesive, or simply generic stippling (See U.S. PTO publication “Guide for Preparation of Patent Drawings (June 2002),” Appendix 3). There is nothing in Toyooka’s Figures 1 and 2 to indicate or in Toyooka’s specification to indicate that the stippling in Figures 1 and 2 represents “colored or lustrous fine fragments,” much less “colored or lustrous fine fragments dispersedly applied onto said adhesive layer.” In fact, it is noted that the lines used in Figures 1 and 2 for the adhesive layer 15 are consistent with the drawing symbol for metals, suggesting that nothing meaningful can be inferred from the drawing symbols used in Toyooka’s drawings.

With respect to the symbol layer 6 mentioned in column 9, line 40, it noted that its purpose is to provide characters or symbols. Such characters or symbols are provided for presenting information such as “ABCD” or “NISSHA” (the shortened company name of Toyooka’s assignee). “Dispersedly applied” as used in the claims with respect to the colored or lustrous fine fragments, means that the fine fragments are randomly dispersed to provide a lustrous appearance. Thus, the dispersedly applied colored or lustrous fine fragments of the invention are very different from Toyooka’s symbol layer 6.

The Office Action further references Figures 1 and 2 and column 5, lines 40-67 and column 6, lines 42-69 as disclosing “[a] painted layer provided on said adhesive layer said colored or lustrous

fine fragments, said painted layer including a light-permeable ink in the form of fine fragments.”

None of the pending claims recite such a limitation. Claim 3 recites “a painted layer formed on the rear face of said section formed of said transparent material, said painted layer including a luminous material in the form of fine fragments.” Claim 6 recites a similar limitation.

Toyooka states at column 5, lines 40-67:

The hiding layer 7 is a layer for occluding the passage of light so as to prevent outward leakage of indicator light from an LED and the like which is mounted inside the cellular phone top cover 20, and defines a transparent display window 21. As an example of the hiding layer 7 other than the one to be described hereinafter, the hiding layer 7 may be a light permeable colored layer formed of a light permeable ink, or a colored layer having a hiding characteristic which is formed of a hiding ink. The transparent display window 21 is a portion which is previous to light so as to enable visual sight of indications from a liquid crystal display or the like mounted inside the cellular phone top cover 20. The transparent display window 21 corresponds to a no-hiding-layer portion on which no hiding layer 7 is laminated. It is possible to arrange the hiding layer 7 so that the ink per se of the hiding layer 7 will appear in the form of character or symbol 16.

Column 6, lines 42-69 state:

Characters or symbols 16 may be formed by no-hiding-ink portions in which no black-colored hiding ink or no white colored hiding ink is formed. Alternatively, characters or symbols 16 may be formed by ink portions in which a black color hiding ink or white color hiding ink is formed. The characters or symbols 16 formed by such no-hiding-ink portions may be colored by the light-permeable inks of the first color layer 13 and of the second color layer 14, or may be colored by a black color hiding ink or white color hiding ink. Thus, colored light-emitting characters or symbols 16, or white color hiding characters or symbols 16 are defined by being surrounded by the black or white color hiding portion. By arranging the hiding portions so that the boundary between the black color hiding portion 8 and the first color hiding portion 10 of the foil-decorating film, or the boundary between the black color hiding portion 8 and the second color hiding portion 11 thereof, or the boundary between the first color hiding portion 10 and the second color hiding portion 11 thereof is positioned in a recessed portion 26 of a transparent resin molded article 17, it is possible to obtain a product without any noticeable border line waviness, color deviation or the like which can enhance its appearance (FIGS. 5 and 10A). The

recessed portion 26 may be such that it is formed by a linear or annular groove (FIG. 10B). Alternatively, the recessed portion 26 may be defined by a stepped portion.

The Office Action is correct in that Toyooka discloses a “painted layer including a light-permeable ink.” Aside from the fact that none of the claims recite such a limitation, it is respectfully submitted that nowhere in these paragraphs is there any description of “colored or lustrous fine fragments,” much less “a light-permeable ink in the form of fine fragments,” as maintained in the Office Action, or a “painted layer including a luminous material in the form of fine fragments,” as recited in claims 3 and 6. Similarly, as discussed above with respect to claim 1, there is nothing in Figures 1 and 2 to indicate or in Toyooka’s disclosure to indicate that anything in Figures 1 and 2 represents “fine fragments,” much less a “painted layer including a luminous material in the form of fine fragments.”

Similarly, Toyooka does not teach “fine powders of colored or lustrous materials dispersedly included in” a body section formed of transparent material, as recited in claims 4 and 7.

Because Toyooka does not teach “colored or lustrous fine fragments dispersedly applied onto said adhesive layer” as recited in claims 1 and 5, Toyooka also cannot teach “a painted layer provided on said adhesive layer and said colored or lustrous fine fragments,” as further recited in claims 1 and 5.

In view of the foregoing, it is respectfully submitted that Toyooka does not teach or suggest the invention as recited in claims 1, 3-7, 9, and 10; that the invention as recited in claims 1, 3-7, 9, and 10 is patentable over Toyooka; and that the rejection should be withdrawn.

Rejections under 35 U.S.C. § 103

1. Claim 8

In paragraph 5 of the Office Action, claim 8 was rejected under section 103(a) as being unpatentable over Toyooka in view of Snyder and Yoshida et al. This rejection is respectfully traversed as being based upon a combination of references that do not teach or suggest the claimed invention.

In the Office Action, Snyder was cited as teaching a “transparent section including a front face and rear face facing said display panel, said front face being formed as a convex lens having a convex surface,” and Yoshida et al. was cited as teaching a “Fresnel lens having a convex lens function is incorporated.”

It is respectfully submitted that Snyder and Yoshida et al. do not overcome Toyooka’s deficiencies as discussed above, i.e., Toyooka, Snyder, and Yoshida et al. in combination do not teach or suggest:

- “an adhesive layer provided on the rear face of said peripheral section” as recited in claim 8
- “colored or lustrous fine fragments dispersedly applied onto said adhesive layer so that the fragments are adhesively held on said adhesive layer” as recited in claim 8
- “a painted layer provided on said colored or lustrous fine fragments” as recited in claim 8

2. Claim 2

In paragraph 6 of the Office Action, claim 2 was rejected under section 103(a) as being unpatentable over Toyooka. This rejection is respectfully traversed as being based upon a reference that does not teach or suggest the claimed invention.

The Office Action states “Kubes doesn’t disclose a luminous material mixed in said section formed of said transparent material by a predetermined ratio.” As the rejection as stated is based solely on Toyooka, the reference to “Kubes” is not understood. As discussed above with respect to the rejection of claims 1, 3-7, 9, and 10, Toyooka does not disclose “a luminous material mixed in said section formed of said transparent material by a predetermined ratio.”

The Office Action further goes on to take “official notice” that this feature of the invention is “notoriously well-known in the art” by way of overcoming this deficiency in Toyooka’s teachings. It is respectfully submitted that it is inappropriate under the present circumstances for the Examiner to take “official note” regarding the alleged notoriety of the mixing of a luminous material into a transparent section of a telephone body.

The procedure for relying on common knowledge or taking official notice is governed by MPEP 2144.03, which states in pertinent part:

In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence. Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence provided the facts so noticed are of notorious character and serve only to “fill in the gaps” which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421.... It is never appropriate to rely

solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 (“[T]he Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”). While the court explained that, “as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction,” it made clear that such “expertise may provide sufficient support for conclusions [only] as to peripheral issues.” *Id.* at 1385-86, 59 USPQ2d at 1697.

In the case of claim 2, the “luminous material” limitation is one of only two limitations recited in the claim. This is not a case of “filling in the gaps” with respect to a limitation in a dependent claim, or a limitation that could in any way be considered peripheral. On the contrary, the Office Action here relies on “official notice” with respect to one-half of the limitations of claim 2, such that it is on equal standing with the cited prior art; that is, it is as much “the principal evidence upon which a rejection was based” as the cited prior art (*Toyooka*). As such, it is clearly inappropriate for the Office Action to rely on “official notice,” and the rejection should be withdrawn.

Conclusion

All rejections have been complied with, properly traversed, or rendered moot. Thus, it now appears that the application is in condition for allowance. Should any questions arise, the Examiner is invited to call the undersigned representative so that this case may receive an early Notice of Allowance.

Favorable consideration and allowance are earnestly solicited.

Respectfully submitted,

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